

REMARKS/ARGUMENTS

This Response and Amendment responds to the Office Action dated September 16, 2004. Claims 11-16, 18, 19, 21-24, 28 and 35-38 are pending in the present application. Claims 11-16, 18-19 and 28 stand rejected. Claims 21-24 and 35-38 are withdrawn from consideration. No amendments are made by this response. Entry of this response is requested.

With Respect to the Rejections Under 35 U.S.C. § 102(e), Paragraphs 13-14 of the Office Action:

Claims 11-16, 19, and 28 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent 6,037,186 to Stimpson. The same rejection was made in the Office Action dated November 17, 2003, but included claim 18 at that time, and was fully responded to in the response dated February 2, 2004. The rejection was then withdrawn in the following Office Action dated April 21, 2004, paragraph 11, the Examiner stating, "[i]n view of applicant's arguments, the rejection of claims 11-16, 18-19 and 28 under 35 USC §102(e) as anticipated by Stimpson (US Patent 6,037,186) has been withdrawn."

The only difference between the rejections is that the Examiner has now added an italicized paragraph at the bottom of page 4 continuing on page 5 citing a passage from the present application as support for the reinstituted rejection. The Applicant strongly protests the reinstitution of this rejection. The present application was filed on April 6, 2001 as a continuation of United States 09/145,140, filed August 28, 1998. The cited passage was present in the present application as originally filed and has not changed. Merely making the rejection not final does not make the Applicant whole. The subject matter of this application is in a technology that changes continually. The longer this application does not have definitive action on the part of the Patent and Trademark Office, the shorter the effective term of any patent that would issue and the less valuable the rights become. The Applicant again strongly protests reinstitution of the rejection and the new rejection.

With respect to the merits of the rejection, the Examiner appears to be indicating that the phrase “or to which target substances can be attached to supply additional structural support” in the application causes the limitation in claim 11 “a bundle of target-strands that has been stabilized by embedding the bundle in a matrix” to read directly on the disclosure from the ‘186 Patent at col. 5, lines 48 et seq. This section begins (emphasis added):

In some cases it may be desirable to use an adhesive compound to bind either the sheets in a stack or the layers of a rolled sheet together to form a cohesive structure. **The adhesive used for this purpose must not migrate during the cutting process used to form the individual arrays or else the edges of the sheet material become covered with adhesive and are not accessible to test solutions. Suitable adhesives for binding the sheets are heat activated-double sided Dow Adhesive Films (Dow Chemical, Midland, Mich.).** The important features of adhesive selection are: (1) the adhesive does not wet and thereby occlude the pores of the sheet material before and during setting (2) the adhesive sets to a substantially solid consistency that does not migrate and cover the sheet edges during cutting (3) the set adhesive is not brittle and susceptible to cracking when the individual arrays are released from the bundle or roll and (4) the adhesive is stable to the aqueous solvent of the test sample. **In general, pressure sensitive adhesives (e.g., Scotch Tape.RTM., 3M, St. Paul, Minn.) are not desirable because of adhesive migration during mechanical cutting.**

First, the phrase cited by the Examiner from page 5, lines 22-24, is not the basis for support for the relevant limitation in claim 11. This phrase defines the use of a matrix in connection with preparing target strands from target substances where the TARGET SUBSTANCES can be embedded in a matrix. Additional relevant disclosure to the phrase cited by the Examiner occurs, for example, on page 6, lines 17-20: “[t]he target substance can be enclosed within the matrix without being chemically bound to the matrix or can be attached to the matrix by covalent forces, by ionic forces, by hydrogen bonding or by other forms of attachment. The tubes are then arranged and secured substantially parallel to their long axes to produce the bundle of target-strands.”

Explicit support for the limitation in claim 11, “sectioning a bundle of target-strands that has been stabilized by embedding the bundle in a matrix,” is instead found on page 8, lines 15-16:

“For example, stabilization can be accomplished by embedding the bundle of target-strands in a matrix, such as epoxy, polypropylene or polystyrene.”

The disclosure of the ‘186 Patent indicates that the “adhesive” being discussed in the ‘186 Patent is not a matrix in which the target-strands can be embedded, as disclosed in the present application, but a “film” having an adhesive on it. The only example a suitable “adhesive” given in the passage is **“heat activated-double sided Dow Adhesive Films (Dow Chemical, Midland, Mich.)”** and the disclosure then explicitly teaches not to use **“pressure sensitive adhesives (e.g., Scotch Tape.RTM., 3M, St. Paul, Minn.)”** obviously because one of ordinary skill in the art reading the disclosure of the ‘186 patent would otherwise assume that “Scotch Tape” would be a suitable “adhesive” as the term is intended to be understood in the ‘186 Patent. Further, this passage EXPLICITLY states that the “adhesive” must not migrate--that is--that it must not end up between the target-strands, using the vernacular of the present application.

Hence, the passage cited by the Examiner from the present application as the basis for reinstituting this rejection is not appropriate to use as the basis for reinstituting the rejection. The passage in the ‘186 Patent cited by the Examiner as the basis for anticipating the relevant limitation in claim 11 does not, in fact, anticipate the limitation. Therefore, withdrawal of this rejection is hereby requested.

With Respect to the Rejections Under 35 U.S.C. § 103, Paragraphs 17-18 of the Office Action:

Claims 11-16, 18, 19, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent 6,037,186 to Stimpson and United States Patent 4,084,308 to Runge for the reasons indicated in paragraphs 17-18 of the Office Action, including the same paragraph added to the reinstituted anticipatory rejection. The Applicant respectfully traverses this rejection because no *prima facie* case of obviousness has been made against claims 11-16, 18, 19, and 28 over United States Patent 6,037,186 to Stimpson and United States Patent 4,084,308 to Runge. As discussed above, the passage in the ‘186

Patent which is apparently being cited by the Examiner neither discloses nor suggests the relevant limitation in claim 11, and in fact teaches away from it explicitly. Nothing in the '308 has been cited by the Examiner makes up for this deficiency. Therefore, withdrawal of this rejection is hereby requested.

With Respect to the Withdrawal of Claims 21-24 and 35-38:

Claims 21-24 stand previously withdrawn as being drawn to a nonelected species. Claims 35-38 are indicated as also withdrawn to a nonelected species for the reason given in paragraph 9 of the Office Action. The above claim listing now indicates that claims 35-38 are withdrawn.

As claims 21-24 and 35-38 depend upon claim 11, and claim 11 is now believed to be in condition for allowance for the reasons indicated above, rejoinder of claims 21-24 and 35-38 is hereby requested. If, however, the United States Patent and Trademark Office still considers claims 21-24 and 35-38 not to be allowable even in view of their dependency upon claim 11, the Applicant authorizes the United States Patent and Trademark Office to cancel claims 21-24 and 35-38 by Examiner's Amendment, if necessary to place the application otherwise in condition for allowance.

CONCLUSION

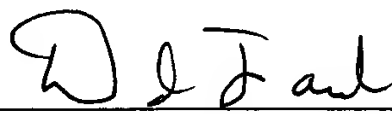
Claims 11-16, 18-19 and 28 are now believed to be in condition for allowance for the reasons stated above and a Notice of Allowance is earnestly solicited. Additionally, the Applicant requests reconsideration of the withdrawal of claims 21-24 and claims 35-38. If, however, there remain any issues that can be resolved by telephone with the Applicant's representative, the Examiner is encouraged to contact the undersigned directly.

If any extension of time is required, such extension is hereby requested. No fee is believed due in connection with this communication. However, if any fee is due, the Commissioner is hereby authorized to charge payment of the fee associated with this communication to Deposit Account No. 19-2090.

Respectfully submitted,

SHELDON & MAK PC

Date: December 16, 2004

By: 
David A. Farah, M.D.
Reg. No. 38,134

SHELDON & MAK PC
A Professional Corporation
225 South Lake Avenue, 9th Floor
Pasadena, California 91101
Tel.: (626) 796-4000
Fax: (626) 795-6321

CUSTOMER NO.: 23676